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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,288	10/20/2000	Dean F. Jerding	A-6686	8077

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	7

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/693,288	JERDING ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-70* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §.119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 41-70 of this application. While the provisional application discloses the general concept of facilitating the extension of a rental, the examiner cannot find support for the claimed limitation for "proving the user with a selectable option during the first access duration, the selectable option being configured to enable the user to access the video presentation during a second access duration that is later in time than the first access duration". In particular, the cited limitation is not particularly be related to the extension of a rental. Rather, it could simply refer to re-renting of a video presentation at a later date. Furthermore, there is inadequate support such that a rental extension is necessarily occurring during the first period as the only reference to a rental extension is in conjunction with the "Rental Period Expiring screen" (Page 7 – Ease of Use).

2. Applicant's claim for domestic priority to US App No. 09/590,520 under 35 U.S.C. 120 is acknowledged. However, the application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 41-70 of this application. In particular, the examiner cannot find support for the claimed limitation for "proving the user with a selectable option during the first access duration, the selectable option being configured to enable the user to access the video presentation during a second access duration that is later in time than the first access duration". Accordingly, the instant application shall be evaluated on the basis of its filling date of 20 October 2000.

Response to Arguments

3. Applicant's remarks with respect to claims 1-40 have been considered but are moot as all of the previously presented claims have been cancelled. A new ground(s) of rejection is presented as follows.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 41, 51, and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Bakoglu et al. (US Pat No. 5,632,681).

In consideration of claims 41, 51, and 61, the Bakoglu et al. reference discloses a method that may be implemented via system orientated means so as to facilitate the delivery of "video content" such as a video game via a "television" (Figure 1). The system comprises a "processor" [203] and a "memory" [203] for facilitating the rental of a "video presentation" or game. In conjunction with the rental process, the viewer "assigns a first access duration to a video presentation" upon which they are "enabled . . . to access the video presentation during the first access duration" as defined by the total number of frames (Col 2, Lines 55-

61). Prior to the expiration of the rental or "during the first access duration", the viewer is "provided . . . with a selectable option being configured to enable the user to access the video presentation during a second access duration that is later in time than the first access duration". Accordingly, upon "receiving a user input corresponding to the selectable option", the viewer is "enabled . . . to access the video presentation during the second access duration" (Col 4, Lines 19-26).

6. Claims 41, 51, and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Noguchi et al. (US Pat No. 5,715,169).

In consideration of claims 41, 51, and 61, the Noguchi et al. reference discloses a method that may be implemented via system orientated means so as to facilitate the delivery of "video content" such as video software via a "television" [13]. The system comprises a "processor" [203] and a "memory" [2] for facilitating the rental of a "video presentation" such as a game. In conjunction with the rental process, the viewer "assigns a first access duration to a video presentation" [306] upon which they are "enabled . . . to access the video presentation during the first access duration". Prior to the expiration of the rental or "during the first access duration", the viewer is "provided . . . with a selectable option being configured to enable the user to access the video presentation during a second access duration that is later in time than the first access duration" so as to extend the original rental (Figure 7). Accordingly, upon "receiving a user input corresponding to the selectable option", the viewer is "enabled . . . to access the video presentation during the second access duration" (Col 7, Line 14 – Col 9, Line 10).

7. Claims 41-44, 47, 49-54, 57, 59-64, 69, and 70 are rejected under 35 U.S.C. 102(e) as being anticipated by Goode et al. (US Pat No. 6,166,730).

In consideration of claim 41, the Goode et al. reference discloses a method for roviding "video content to a user via a television" as illustrated in conjunction with Figure 1. The method involves "assigning a first access duration" or view time to a "video presentation selected by a user" in conjunction with the video ordering process (Col 14, Lines 11-25; Col 14 Line 55 – Col 15, Line 22). A user is subsequently "enabled . . . to access the video presentation during the first access duration". "During the first access duration", the user is provided with a "selectable option" [1025] to order a second copy of the same title during a "second access duration that is later in time than the first access duration" in conjunction with following a purchase process similar to that followed in conjunction with the original ordering process (Figure 7; Col 17, Lines 32-54). The "second access duration" is subsequently later than the first given that it is established after the "first access duration" has already begun. For example, the first copy of the presentation may be ordered at 7 AM with a 24 hour default view time. The second copy may be ordered at 7 PM with a 24 hour default viewer time. Accordingly, the "second access period" is later than the first. Based on "receiving a user input corresponding to the selectable option", the embodiment is operable to "enable the user to access the video presentation during the second access duration" on a second set-top terminal.

Claim 51 is rejected wherein the method is implemented via a system comprising "at least one memory having stored thereon program code" [402] and "at least one processor that is programmed by at least the program code" [400] (Col 15, Lines 8-33).

Claim 61 is rejected wherein the system comprises the "means" (Figure 2) for implementing the method of claim 1.

Claims 42, 52, and 62 are rejected wherein the "video presentation is a video-on-demand movie" (Col 13, Line 65 – Col 14, Line 10) wherein the "total time period corresponding to the first access duration is greater than or equal to a total uninterrupted play time of the video presentation" (Col 14, Lines 11-25).

Claims 43, 53, and 63 are rejected wherein the "user is provided with a plurality of selectable options during the first access duration" similar to those associated with the ordering of the original presentation. Accordingly, "each of the selectable options [has] a corresponding access duration that is later in time than the first access duration" and is "configured to enable the user to access the video presentation during the corresponding access duration" (Col 14, Line 64 – Col 15, Line 13; Col 17, Lines 31-45).

In consideration of claims 44, 54, and 64, the Goode et al. reference discloses that the user is "provided . . . with information identifying a plurality of prices" (Col 4, Lines 63 – Col 5, Lines 9) wherein the "plurality of prices correspond to a respective one of the plurality of selectable options" such that the price associated with a second copy or ordering of a "second access duration" maybe offered at a discount over that originally paid (Col 17, Lines 39-45).

In consideration of claims 47, 57, and 67, the Goode et al. reference explicitly incorporates a detailed description of the navigator presented in the Gordon et al. (US Pat No. 6,208,335) reference (Col 11, Lines 12-15). As illustrated in Figure 17 of the Gordon et al. reference the embodiment may "provide said user with information regarding a media

presentation remaining rental time". This screen may be presented "prior" to or after the ordering of a media presentation.

Claims 49, 59, and 69 are rejected wherein the user may be "provided with pricing information related to the time period extension" (Col 4, Lines 33-46, 63 – Col 5, Line 9; Col 14, Line 63 – Col 15, Line 2).

Claims 50, 60, and 70 are rejected wherein the user is "charged" a "first price in connection with the first access duration" and a "second price in connection with the second access duration, wherein the first price is different from the second price" (Col 17, Lines 39-45).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 45, 55, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bakoglu et al. (US Pat No. 5,632,681).

In consideration of claims 45, 55, and 65, as aforementioned, the reference discloses the particular usage of the "selectable option" to extend a duration as well as providing the user with an "interruption in the video presentation" in conjunction with an alert to the user that the rental period is about to expire (Col 4, Lines 19-26). However, it is unclear if the "selectable option is provided during an interruption in the video presentation". Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Bakoglu et al. reference, if necessary, to provide the "selectable option" during the "interruption in the video presentation" for the purpose of providing the user with a friendly and convenient method for extending the current rental. For example, given such a modification, the "interruption" or alert would further comprise the "selectable option" with a simple message such as "Your rental is about to expire. Do you wish to extend your rental?".

11. Claims 46, 48, 56, 58, 66, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al. (US Pat no. 6,166,730).

In consideration of claims 46, 56, and 66, the Goode et al. reference discloses that the embodiment stores a "viewing time" [624] and a "use time" [623], either collectively or separately interpreted as an "access duration" time. The reference discloses that the embodiment is operable to determine if there is "insufficient rental time remaining for viewing a remainder of the media rental", that the presentation will not be terminated until the user terminates the presentation or the movie concludes (Col 16, Lines 42-59).

Accordingly, a user who temporarily or mistakenly leaves a movie presentation in progress whose "access duration" has expired would unexpectedly be unable to return to the movie as it would no longer be available as an active media presentation as illustrated in Figure 17 of the Gordon et al. reference. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to "alert" the user that there is "insufficient rental time remaining" prior to the exiting of the presentation for the purpose of providing the user with a user friendly reminder that they will have to reorder the presentation should they exit the presentation. Such a reminder may advantageously reduce the number of dissatisfied customers and number of account credits (Gordon et al.: Figure 13).

In consideration of claims 48, 58, and 68, the Goode et al. reference discloses that the "remaining playing time" [624] may be stored and utilized in conjunction determining whether or not to close a session (Col 15, Lines 34-42). The reference, however, does not explicitly disclose nor preclude the display of this information to the subscriber. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to "provide said user with information regarding a media presentation remaining-playing time corresponding to a remainder of the video presentation, the remainder being calculated from a current interruption point in the video presentation" for the purpose of reminding the user as to remaining viewing time [624] currently available for the selected program. This information would be particularly valuable in a multiple set-top environment (Figure 10) given that the viewer who orders the presentation may not realize that another viewer within the household has previously watched the media presentation,

hence creating the situation wherein the viewer who ordered the presentation may find it ending unexpectedly or unable to watch the movie a second time.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Javed et al. (US Provisional Serial No. 60/153,735) explicitly incorporated by reference as if set forth in its entirety in the Javed (US Pub No. 2001/0036271) reference of record discloses details pertaining to the process for extending the rental of a video program.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

SEB
February 18, 2004